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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/619,825	07/14/2003	Polly Lyons	L604-002-PAT	7385
7590	04/26/2006		EXAMINER	
Angenehm Law Firm. Ltd. P.O. Box 48755 Coon Rapids, MN 55448-0755			LIN, JAMES	
			ART UNIT	PAPER NUMBER
			1762	

DATE MAILED: 04/26/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/619,825

Applicant(s)

LYONS ET AL.

Examiner

Jimmy Lin

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 13-18 is/are pending in the application.
- 4a) Of the above claim(s) 1-12 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 13-18 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 12/15/2003.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

Election/Restrictions

- I. Claims 1 - 12, drawn to a kit, classified in class 206, subclass 229.
- II. Claims 13 - 18, drawn to a method, classified in class 427, subclass 140.

The inventions are distinct, each from the other because of the following reasons:

1. Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product. See MPEP § 806.05(h). In the instant case the kit as claimed can be used to apply graffiti, or any surface application requiring no surface preparation.
2. Because these inventions are independent or distinct for the reasons given above and have acquired a separate status in the art in view of their different classification, restriction for examination purposes as indicated is proper.
3. Because these inventions are independent or distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.
4. During a telephone conversation with Mr. Friederichs on February 23, 2005 a provisional election was made with traverse to prosecute the invention of Group II, claims 13 - 18. Affirmation of this election must be made by applicant in replying to this Office action. Claims 1 - 12 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. Claims 13 - 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Alvarez (US 6,439,381) in view of Petersen, Jr (US 4,538,740), <http://www.monokote.com/lustrekote/painting-tips/topr7200tip2.html> (hereafter MonoKote), and <http://muextension.missouri.edu/xplor/wasteman/wm6001.htm> (hereafter MUEExtension.com).

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9. Regarding claim 13, Alvarez discloses an apparatus performing touching up jobs that includes a rack (i.e., a carrier), containers, and paint applicators (i.e., brushes) (column 1, lines 20 – 24). As seen in Fig. 2, the rack is defined by depressions for storing the containers. The containers have threaded caps, wherein the threads can attach to one of the paint applicators, but the caps do not have a flip top. However, Petersen, Jr teaches a flip-top pour spout that is provided for convenience and controlled dispensing of the contents of the bottle (column 4, lines 7 – 10). Thus, It would have been obvious to one of ordinary skill in the art at the time of invention to use a flip-top pour spout on a bottle. One would have been motivated to do so in order to control the dispensing of the contents in the bottle.

With respect to the apparatus of Alvarez, one would expect to select a brush from the rack, remove a container from the rack, apply the paint, and store the container and paint contained therein back on the rack in order to touch up paint. Alvarez is silent to these steps, but the apparatus is designed such that these steps are expected.

Alvarez discloses an apparatus that is capable of being used as claimed (i.e., selecting a brush from a carrier, removing a container from the carrier, applying the paint, and storing the container and paint contained therein), but does not teach preparing the surface to be painted. However, MonoKote teaches that sanding (i.e., preparing the surface) is important before painting any surface (paragraph 1, line 1). Thus, It would have been obvious to one of ordinary skill in the art at the time of invention to sand the surface before applying paint. One would have been motivated to

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do so in order to obtain a better appearance of the painted surface (paragraph 1, lines 2 – 3).

Alvarez discloses an apparatus that is capable of being used as claimed, but does not teach storing the container and paint contained therein, cap-side down. However, MUExtension.com teaches that paint should be stored upside-down, so that the paint will form a seal around the lid and the paint will remain useable (paragraph 12, line 1 – 2). The apparatus in Alvarez provides a means to store unused paint (column 1, lines 20 – 21), and the containers therein are capable of being stored cap-side down in the rack. Therefore, It would have been obvious to one of ordinary skill in the art at the time of invention to store the containers of Alvarez cap-side down in the rack. One would have been motivated to do so in order to form a seal around the lid and keep the paint more useable.

10. Regarding claim 14, MonoKote teaches that sanding (i.e., preparing the surface) is important before painting any surface (paragraph 1, line 1).

11. Regarding claim 15, Alvarez discloses that the paint applicators include a roller (column 1, lines 24 – 25).

12. Regarding claim 16, Alvarez discloses that a funnel is used for filling the containers with paint (column 1, lines 31 – 32).

13. Regarding claim 17, Alvarez teaches that the excess paint would be funneled into a container(s) whenever a painting job has been completed (column 2, lines 35 – 37). As stated above, a rack is defined by depressions for storing containers, and it

would be obvious to place the containers back in the depressions of the rack after they have been filled with paint.

14. Regarding claim 18, Alvarez discloses that the containers each have a label identifying the paint color and room on which the paint was used (column 2, lines 5 – 8), but does not teach writing the date the room was painted with the paint color. The labels of Alvarez can be written on with any information in addition to the above stated information. One would be motivated to write the date of painting to know the age of the paint to ensure it does not exceed its useful shelf life. Therefore, it would have been obvious to write the date in which the room was painted on the label.

Conclusion

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Mann (US 5,992,030) discloses a paint kit.

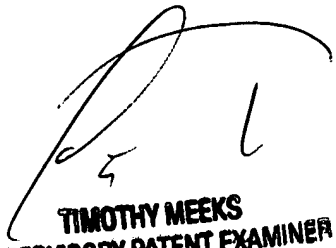
<http://www.factsfacts.com/MyHomeRepair/storingpaint.htm> teaches storing paint cans upside down.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jimmy Lin whose telephone number is 571-272-8902. The examiner can normally be reached on Monday thru Thursday 8 - 5:30 and Friday 8 - 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tim Meeks can be reached on 571-272-1423. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



TIMOTHY MEEKS
SUPERVISORY PATENT EXAMINER